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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,179	10/30/2001	Brian Pond	05236-1025	7667
7590	10/17/2003			EXAMINER PASSANITI, SEBASTIANO
Mitchell P. Brook, Esq. BAKER & MCKENZIE 12th Floor 101 West Broadway San Diego, CA 92101-3890			ART UNIT 3711	PAPER NUMBER
			DATE MAILED: 10/17/2003 1	

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

This Office action is responsive to communication received 07/25/2003 – Response to Election of Species Requirement.

Claims 1-39 remain pending.

The reply filed on 07/25/2003 is not fully responsive (37 CFR 1.111) to the prior Office Action because of the following omission(s) or matter(s):

The response to the election of species requirement indicates an election of Species I (Figures 1-4) and further indicates that all of claims 1-39 are to be examined, noting more specifically that each of independent claims 1, 21 and 34 is generic to all of the species identified in the requirement. The applicant continues by noting that there would not appear to be any serious burden to search the entire application.

A review of both the application and the requirement for election of species indicates that each of the independent claims 1, 21 and 34 is not generic to all of Species I-III. By way of example only, independent claim 1 recites a "center section including a cavity structured to receive an insert". Species III (Figures 7, 8) does not show a center section having a cavity that is structured to receive an insert. Instead, Species III illustrates a golf club head having three distinct sections, namely a toe, heel and center section. A similar observation may be made when reviewing independent claim 21 and Species III. By way of another example, independent claim 34 requires a substantially transparent insert positioned in the cavity and adjacent to a floor of the cavity. Again, Species III only shows a toe, heel and center section, with no indication

of a center section including a cavity that is provided with a transparent insert adjacent the floor of the cavity.

MPEP §809.02(a) states that to be complete, a reply to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. In this case, the mere listing that all of claims 1-39 and the alleged statement that all of claims 1-39 correspond to Species I is insufficient to identify those claims that may be restricted to a single disclosed embodiment (MPEP §806.04(e)).

In reviewing the requirements for appropriateness of a restriction requirement, note that the question here is not whether or not there is a serious burden to examine all of the claims, as would be the case pending the inclusion of claims drawn to different inventions. Rather, the question is whether plural species of a single invention have been justifiably identified and set forth in the requirement for election. Note, species are always the specifically different embodiments of an invention (MPEP §806.04(e)). In this case, one invention is disclosed with three independent species. Next, one must consider whether the species are patentably distinct, one from the other. If the applicant is attempting to set forth a traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a **ONE (1) MONTH or THIRTY (30) DAYS SHORTENED STATUTORY PERIOD** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Pasaniti/sp
October 16, 2003